REMARKS

In the Final Office Action of December 5, 2008, claims 1-9 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Applicant's admitted prior art (hereinafter "AAPA") in view of U.S. Patent Number 4,646,327 (hereinafter "Kojima et al."). Furthermore, claims 10 and 11 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over AAPA and Kojima et al. in view of U.S. Patent Number 4,118,739 (hereinafter "Umehara").

In response, Applicant respectfully asserts that the independent claims 1 and 5 are not obvious in view of AAPA and Kojima et al., as explained below. In view of the following remarks, Applicant respectfully requests the allowance of the independent claims 1 and 5, as well as the dependent claims 2-4 and 6-11.

A. Patentability of Independent Claims 1 and 5

The independent claims 1 and 5 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over AAPA in view of Kojima et al. However, the Office Action has failed to establish a *prima facie* case of obviousness for the independent claims 1 and 5. Thus, the independent claims 1 and 5 are not obvious in view of AAPA and Kojima et al.

Applicant again asserts the arguments made in the last Office Action response, which is not repeated herein, in support of the conclusion that the independent claims 1 and 5 are not obvious in view of AAPA and Kojima et al. In addition, Applicant will address Examiner's response to arguments on pages 2 and 3 of the latest Office Action.

In response to Applicant's argument that "modification of Applicant's background of invention in view of Kojima would be unsatisfactory for its intended purpose; therefore there is no suggestion or motivation to make the proposed modification," the Examiner asserts that "it is always desirable in communication

systems to reduce the distortions of the signal" and that "by modifying Applicant's background of invention as taught by Kojima, the distortions in the communication system can be corrected (see column 1, lines 1-18)."

While Applicant agrees that "it is always desirable in communication systems to reduce the distortions of the signal," Applicant fails to see how this desired reduction of signal distortions will motivate one of ordinary skill in the art to make the proposed modification when the resulting device will be unsatisfactory for its intended purpose. As previously explained, the application of the teachings of Kojima et al. to the data carrier 1 of AAPA will not produce the desired signal, i.e., the load-modulated signal S shown in Fig. 1 or 2. Thus, it is not reasonable to expect one of ordinary skill in the art to apply the teachings of Kojima et al. to the data carrier 1 of AAPA when the resulting device will not operate in the manner it was intended, i.e., not producing the expected load-modulated signal S shown in Fig. 1 or 2. Thus, there is no reasonable motivation to modify the data carrier 1 of AAPA by applying the teachings of Kojima et al. in the manner suggested by the Examiner.

In response to Applicant's argument that "if the data carrier 1 of AAPA is modified to include the waveform shaping apparatus 11 and the low-pass filter 13 of Kojima the signal applied to the modulation means 11 of the data carrier 1 of AAPA would have more than two levels and the modified data carrier will be rendered unsatisfactory for its intended purpose," the Examiner asserts that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references" but rather "the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art."

Applicant respectfully suggests that the Examiner look at Section 2145 of the MPEP under the heading "III. ARGUING THAT PRIOR ART DEVICES ARE NOT PHYSICALLY COMBINABLE." The last sentence under this heading states the following: "However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01." Thus, since Applicant has set forth arguments that

the proposed modification would render the data carrier 1 of AAPA unsatisfactory for its intended purpose (which are not disputed by the Examiner), Applicant respectfully asserts that it is not obvious to make the modification as suggested by the Examiner. Therefore, the independent claims 1 and 5 are not obvious in view of AAPA and Kojima et al. As such, Applicant respectfully requests that the independent claims 1 and 5 be allowed.

B. Patentability of Dependent Claims 2-4 and 6-11

Each of the dependent claims 2-4 and 6-11 depends on one of the independent claims 1 and 5. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that these dependent claims are allowable for the same reasons as their respective base claims. Furthermore, the dependent claims may be allowable for additional reasons.

As an example, claims 10 and 11 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over AAPA and Kojima et al. in view of Umehara. As correctly stated on pages 6 and 7 of the Office Action, the cited reference of Umehara discloses a waveform shaper 10 which is an integrating circuit consisting of a capacitor 42 and a resistor 43, and a modulator 13 comprising a transistor 25. However, as explained in column 3, lines 63-67, of Umehara, the "waveform shaper 10 is an integrating circuit consisting of a capacitor 42 and a resistor 43 and integrates the horizontal flyback pulses having a positive polarity as shown in FIG. 2(a) into a sawtooth waveform as shown at numeral 101 in FIG. 2(b)." Thus, the waveform shaper 10 operates on a particular signal, i.e., horizontal flyback pulses, to change the signal into a desired waveform, i.e., a sawtooth waveform. However, the data carrier 1 of AAPA and the waveform shaping apparatus 11 of Kojima et al. do not use horizontal flyback pulses. Thus, one of ordinary skill in the art would not have applied the teachings of Umehara with respect to the waveform shaper 10 since the waveform shaper 10 is used on horizontal flyback pulses to produce a sawtooth waveform for a particular application, i.e., a switching regular for a television receiver. Therefore, claims 10 and 11 are not obvious in view of AAPA, Kojima et al. and Umehara.

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

Ewald Bergler

Date: February 5, 2009

By: /thomas h. ham/
Thomas H. Ham
Registration No. 43,654
Telephone: (925) 249-1300